

REMARKS

This is a full and timely response to the outstanding final Office Action mailed September 21, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1, 6-9, 16-17, and 19-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Thibadeau, et al. ("Thibadeau," U.S. Pat. No. 5,565,909) in view of Helperich (U.S. Pat. No. 6,636,733). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, there is no suggestion or motivation to combine the references or make the modifications proposed in the Office Action. Furthermore, the prior art references, when combined, do not teach or suggest all of Applicant's claim limitations. Applicant discusses the applied references and Applicant's claims in the following.

The Thibadeau reference has now been cited to account for the deficiencies of the Helferich reference identified in the previous Office Action. As an initial matter, Applicant notes that the Thibadeau reference pertains to *set-top receivers*, not advertisement presentation systems and methods as claimed by Applicant. The nature of Thibadeau's disclosure can perhaps be best understood from Thibadeau's "Summary of the Invention," which provides in part (emphasis added):

It is an object of the invention to enable identification of receivers to selectively process generally broadcast data or programming, by means of encoding arbitrary position information respecting one or both of the content of the generally broadcast information and the area of interest of a user of the receiver. In this context, a "receiver" is construed to include a variety of tuner-equipped devices such as television receivers, VCRs, cable interface boxes and the like, whereby a signal is selected.

Traditional broadcast of digital information has taken two approaches: either direct addressing of a particular recipient or a "universal broadcast" to all recipients. Traditionally these are intermixed, where some information is directed and some universally available. When the directed approach is used, and a large amount of identical information must be sent to some, but not all, recipients, the

amount of information broadcast is proportional to the number of recipients. In a "universal broadcast", information cannot be restricted from certain recipients, and all recipients must respond to each of the broadcast digital packets to determine if the material contained therein is of interest.

This invention embodies a technique of controlling or filtering information based on the geographic location of the recipient.

Accordingly, Thibadeau's invention is used to control what information is sent to television signal receivers based upon the geographical location of those receivers. Given this fact, it is questionable why the Thibadeau reference has been used as a base reference in rejecting Applicant's claims, which are directed to such a different application. Nevertheless, Applicant discusses the particulars of the rejection in the following.

In regard to the Thibadeau reference, the Office Action states the following:

With respect to claims 1, 6, 9, 16-17, 20-23, 26, 29 Thibadeau teaches a method for controlling the presentation of advertisements, the method being practiced by a local computing device having a processing device and a memory (Abstract). Receiving local weather information from a sensing unit that is separate from the computing device and transmitted from a remote server via a network (col. 4, lines 14-24 and col. 13, lines 13-61).

Contrary to that alleged in the above excerpt, Thibadeau does not teach a "method for controlling the presentation of advertisements." Again, Thibadeau teaches a method for controlling what information is provided to a television-type receiver (e.g., set-top box) based upon the receiver's geographical location. Nowhere in the Thibadeau

reference is it stated that such information is advertisement information. Indeed, the example contained in the Thibadeau reference that is cited in the Office Action pertains to information about "bus service." See Thibadeau, column 13, lines 45-61. That the underlying information is so different is understandable given that the Thibadeau system serves a completely different purpose than Applicant's claimed inventions.

As for the Office Action's allegation that the Thibadeau system receives local weather information from a sensing unit that is separate from the computing device, Applicant notes that nowhere, including the portions of the Thibadeau reference explicitly identified in the Office Action, does Thibadeau describe receiving local weather information. Furthermore, Applicant notes that Applicant does not merely claim "receiving local weather information." For example, in claim 1, Applicant recites "receiving local weather condition information from a sensing unit that is separate from the computing device". The Office Action has identified no such "sensing unit" of the Thibadeau system.

Regarding the Office Action's allegation that the Thibadeau system transmits the local weather information from a remote server, Applicant notes that, since the Thibadeau system is not described as collecting weather information, it logically follows that the Thibadeau reference does not teach transmitting weather information from a remote server.

In view of the above shortcomings of the Thibadeau reference, the rejection fails to state a *prima facie* case for obviousness that properly accounts for each of Applicant's claim limitations. The rejection is improper for at least this reason, and should be withdrawn.

Regarding the combination of the Thibadeau reference and the Helferich reference, the Office Action states as follows (emphasis added):

Thibadeau does not specifically teach that the messages transmitted as advertisements. Helferich teach advertisements that are based on the measured weather condition. A weather of 98 degrees will provide an advertisement for Coke)(col. 10, lines 10-15). *It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have replaced the warnings information with the advertisements of Helferich because such a modification would motivate and would increase the consumption of certain products based on the weather condition.*

As a first point, it is peculiar that the Office Action admits that Thibadeau does not teach anything about advertisements given that the Office Action, on a previous page, states that Thibadeau teaches a "method for controlling the presentation of advertisements." This point notwithstanding, the motivation for combining the teachings of Helferich with those of Thibadeau and for modifying the Thibadeau system lack merit. Specifically, given that the Thibadeau disclosure has nothing to do with advertising or weather information, why would a person having ordinary skill in the art be motivated to "replace" Thibadeau's warnings (e.g., regarding a bus service) with Helferich's advertisements? This just does not make sense.

It appears clear that the true motivation for the proposed combination and modification is the motivation to account for Applicant's various claim limitations to reject them, without regard for the actual teachings provided by the art. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367,

62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

With specific regard to dependent claims 7 and 27, the Office Action takes official notice that advertisement displays on fuel pumps are known, and then concludes that “[i]t would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to have included presentation of the ads is [sic] on a display mounted to a fuel pump in order to achieve the above mentioned advantage.” This reasoning is problematic. Although Applicant acknowledges that the Office Action is taking official notice as to the existence of fuel pump displays, the Office Action still must identify a teaching or suggestion from the prior art to apply what is alleged to be taught by Thibadeau and Helferich to such a fuel pump display. No teaching or suggestion has been identified, and no teaching or suggestion is provided by the applied references.

Regarding claims 24-25, the Office Action admits that neither Thibadeau nor Helferich teaches a correlation table, and yet concludes that it would have been obvious to provide such a correlation table in the proposed combination of Thibadeau’s and Helferich’s systems. Clearly, there is no support in the prior art for this argument. As such, the argument fails to rise to the level of a *prima facie* case for obviousness.

In summary, it is Applicant’s position that a *prima facie* for obviousness has not been made against Applicant’s claims. Therefore, it is respectfully submitted that each of these claims is patentable over the Thibadeau/Helferich combination and that the rejection of the claims should be withdrawn.

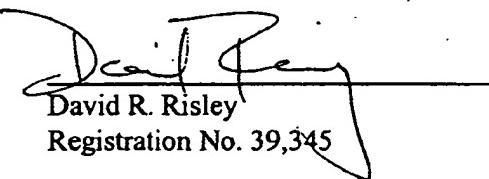
Canceled Claims

As identified above, claim 17 has been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicant reserves the right to present that claim, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David R. Risley
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

11-4-04

Mary M. Hogan
Signature